

Amendment and Response under 37 CFR §1.116

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Applicant(s): Nancy D. HANSON et al.

Serial No.: 09/814,257

Filed: 21 March 2001

For: PRIMERS FOR USE IN DETECTING BETA-LACTAMASES

Remarks

The final Office Action mailed 11 December 2003 has been received and reviewed. Claims 17, 39, 41, 43, 47, 49, 52, 53 and 54 having been amended and claims 12-16 and 51 having been allowed, the pending claims are claims 12-17, 39-44, 47-49, and 51-54. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowed Claims

Applicants note the indication that claims 12-16 and 51 are allowable

The 35 U.S.C. §112, Second Paragraph, Rejection

The Examiner rejected claims 17, 39-44, 47, 48, and 52-54 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Specifically, the Office Action indicated that the language of claims 17 and 52-54 is unclear with regard to "the pair" and "each pair" in a phrase directed to the same pair of oligonucleotide primers. The Examiner has suggested amending claims 17 and 52-54 to change "each pair" to "the pair" in order to make the first part of the phrase correspond to the second part. Applicants have amended the claims accordingly herein.

The Examiner further suggested the language of claims 17 and 52-54 is unclear with regard to the phrase "wherein each extension product after separation from the beta-lactamase nucleic acid serves as a template for the synthesis of an extension product for the other primer of each pair." Applicants have amended these claims according to the Examiner's suggestion. Specifically, the phrase "for the other primer of each pair" has been changed to "using a primer that is complimentary to each extension product".

Finally, the Examiner's suggestion to amend the language of claims 17 and 54 from "the enzyme" to "the enzymes" has not been made; however the previous reference to "enzymes" has been amended to "enzyme".

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Applicants thank the Examiner for indicating these amendments will overcome the rejections under U.S.C. 112, second paragraph.

The 35 U.S.C. §102(a) Rejection

The Examiner rejected claims 17, 39, 41, 43, 47, and 54 under 35 U.S.C. §102(a) as being anticipated by Vahaboglu et al. (J. Clin. Microbiology, 36, 827-829, March 1998). These claims have been amended to clarify that the primers used for amplification are specific for nucleic acid encoding an OXA family beta-lactamase enzyme found in a specific group of Gram-negative bacteria, thereby rendering this rejection moot.

The 35 U.S.C. §103(a) Rejection

The Examiner rejected claim 49 under 35 U.S.C. §103(a) as being unpatentable over Vahaboglu et al. (March 1998) as applied to claims 17, 39, 41, 43, 47, and 54 above, and further in view of Fluit et al., (WO 91/08305). Claim 49 has been amended to clarify that the primers used for amplification are specific for nucleic acid encoding an OXA family beta-lactamase enzyme found in a specific group of Gram-negative bacteria, thereby rendering this rejection moot.

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Summary

It is respectfully submitted that the pending claims 12-17, 39-44, 47-49, and 51-54 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
HANSON et al.,

By
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March 11, 2004

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Commissioner for Patents, Mail Stop AP, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11th day of March, 2004, at 4:41 pm (Central Time).

By: *Sara E. Olson*
Name: Sara E. OLSON